Remarks

1. Summary of the Office Action

Following the Notice of Panel Decision from Pre-Appeal Brief Review, which directed the Examiner to re-open prosecution, the Examiner mailed a new, non-final office action dated June 27, 2006. In the new office action, the Examiner rejected all of the pending claims 1-13 and 30-32 under 35 U.S.C. § 103(a) as being allegedly obvious over U.S. Patent No. 7,058,601 (Paiz)

2. Status of the Claims

Presently pending are claims 1-13 and 30-32, of which claims 1, 6, 10, and 12 are independent. These claims are all directed to a method for advertising on a subscriber terminal.

As recited in claim 1, an advertising authorization request is sent to the subscriber terminal via an electronic communications network. Then, a reply to the authorization request is received from the subscriber terminal, the reply including an authorization for an advertisement to be sent to the subscriber terminal. Given the authorization, the advertisement is then sent to the subscriber terminal when a triggering event occurs.

Claims 6 and 12 similarly include the authorization request and/or reply and also recite displaying the advertisement on the subscriber terminal when at least one triggering event occurs. And claim 10 similarly includes the authorization request and reply and sending the advertisement to the subscriber terminal when at least one triggering event occurs.

Dependent claims 2, 7, and 11 further define the triggering event as either the subscriber terminal being idle or the subscriber terminal being substantially stationary. And dependent claims 5 and 9 further limit the method by defining the triggering event as the subscriber terminal being *both* idle *and* substantially stationary.

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3. Response to § 103 Rejection

Applicant submits that the Examiner's rejection of the pending claims as being obvious over Paiz is clearly erroneous and should be withdrawn.

Paiz discloses nothing whatsoever about sending an advertising authorization request to a subscriber terminal. Paiz also discloses nothing whatsoever about receiving an advertising authorizing reply from a subscriber terminal. Further, Paiz discloses nothing whatsoever about triggering the sending of an advertisement to a subscriber terminal after receiving or retrieving an advertising authorization reply. Paiz thus completely fails to disclose or suggest Applicant's claimed invention.

The only item of even potential relevance in Paiz is the disclosure of selling advertising to be delivered and displayed to subscribers, so as to minimize or eliminate the cost of user subscriptions to the Paiz trading-related service. (*See* Paiz, at column 4, lines 9-11; column 5, lines 50-60). Yet, at best, all this teaches is the concept of sending advertisements to subscriber. It teaches nothing at all about sending an advertising authorization request to a subscriber terminal, receiving an advertising authorization reply from a subscriber terminal, or triggering the sending of an advertisement to a subscriber after receiving or retrieving an advertising authorization reply.

In rejecting the claims, the Examiner provided very little in the way of rationale for rejecting the claims. The Examiner stated:

> Paiz discloses a computer network, e.g. 10, 20, where advertising messages are directed to a computer terminal, e.g. 28, after a triggering event, e.g. col. 5. Paiz does not disclose the term reply. However, Paiz discloses that a subscriber identifies himself, e.g. cols. 3-4, lines 64-11, and receiving instructions. It is further noted that the broad concept of providing a reply to an advertising authorization request from a entity and then receiving at least one advertisement in response to the reply has been common knowledge in the advertising art. Official Notice of such is taken. To have provided a reply to an advertising

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> authorization request from a subscriber for Paiz would have been obvious to one of ordinary skill in the art. The motivation would have been to incorporate common knowledge business practice with the Paiz disclosure.

(*See* office action, page 2 (sic throughout)). However, this reasoning by the Examiner is deficient and fails to establish *prima facie* obviousness of Applicant's claims.

First, the fact that Paiz discloses a subscriber identifying himself and receiving instructions is not relevant to the present invention and does not in any way suggest the advertising authorization request/reply functionality recited in the pending claims.

Second, notwithstanding the Examiner's subjective asserted belief that providing a reply to an advertising authorization request and then receiving a reply is "common knowledge in the advertising art," the Examiner has not identified any objective evidence that discloses or suggests carrying out those functions or the functions as specifically recited in Applicant's claims. Rather, the Examiner opted to take "official notice" of such a concept.

M.P.E.P. § 2144.03 instructs that "[i]t is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." Yet, given the fact that Paizo teaches nothing at all about the advertising authorization requests or replies as in Applicant's claims, the Examiner has effectively relied on the alleged "common knowledge" as the principal basis for the rejection. Therefore, under M.P.E.P. § 2144.03, the Examiner's reliance is impermissible.

Under M.P.E.P. § 2143, the Examiner bears the burden to establish *prima facie* obviousness, including pointing to objective evidence that would have motivated those of ordinary skill in the art to achieve the claimed invention. In this case, the Examiner has not specifically pointed to any such objective evidence. Consequently, the Examiner has not

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established *prima facie* obviousness. Accordingly, Applicant submits that all of the pending claims are allowable.

Applicant thus respectfully requests favorable reconsideration and allowance.

Respectfully submitted,

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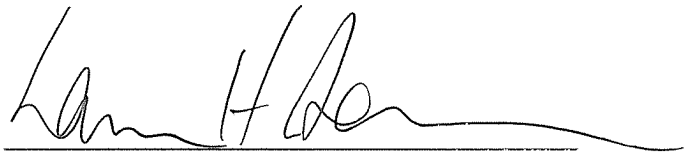
Date: September 25, 2006 By: 

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